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In re Application of:

Spohn, Michael A., et al.

Serial No.: 10/826,149

Filed: Apr. 16, 2004

Docket: CV/04-002

Title: FLUID DELIVERY SYSTEM, FLUID
PATH SET, STERILE CONNECTOR
AND IMPROVED DRIP CHAMBER
AND PRESSURE ISOLATION
MECHANISM

DECISION ON PETITION

This is a decision on the petition filed on Jun. 14, 2007 by which petitioner requests reconsideration and withdrawal of the restriction requirement mailed Aug. 2, 2006, and that non-elected claims 27-59 be rejoined and examined on the merits. Claims 60-75 were elected and examined. This petition is being considered pursuant to 37 CFR 1.144 and 37 CFR 1.181, and no fee is required.

The petition is granted.

A review of the record reveals that a restriction requirement was issued on Aug. 2, 2006. On Aug. 10, 2006, the applicant elected Group VI (claims 60-75) with traverse. The examiner issued an action of the merits on Sep. 29, 2006 and repeated the restriction requirement. On Jun. 14, 2007, the current petition is filed requesting the non-elected claims 27-59 be rejoined because the examiner has not established that at least the inventions of Groups IV, V, and VI are independent and distinct as claimed.

In judging the propriety of the restriction requirement, the related inventions, as claimed, must be shown to be distinct. See MPEP 802.01. The inventions can be shown to be distinct if both of the following can be shown: that a combination as claimed in first group: (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness) and (B) the subcombination as claimed in second group can be shown to have utility either by itself or in another materially different combination. See MPEP 806.05(c)¹.

¹ MPEP 806.05(c) [R-5] Criteria of Distinctness Between Combination and Subcombination: To support a requirement for restriction between combination and subcombination inventions, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., there would be a "serious search burden" if restriction were not required as evidenced by separate classification, status, or field of search. See MPEP §808.02. The inventions are distinct if it can be shown that a combination as claimed: (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in another materially different combination. When these factors cannot be shown, such inventions are not distinct.

In the instant application, the distinctness between the claimed inventions has not been established for the inventions of Groups IV, V and VI in the examiner's restriction requirement of Aug. 2, 2006 because the combination claim 60 does in fact include all limitations of subcombination claims 27 and 42. Therefore, the combination claim 60 does require the particulars of the subcombination claims 27 and 42 for patentability. Therefore, the claims as Grouped in IV, V and VI are not distinct from each other. Whether the subcombinations as claimed have separate utility becomes irrelevant since the examiner has not shown the combination as claimed does not require any particulars of subcombination for patentability. In the restriction requirement, the examiner simply has not satisfied the requirement set forth in MPEP § 806.05(c). It is noted that petitioner does not dispute the distinctness between the inventions as Grouped in I and II (claims 1-26) under the restriction requirement. Therefore, this decision will not address the propriety of the restriction requirement as to the inventions of Groups I and II (claims 1-26).

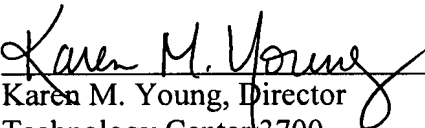
In finding petitioner's points of argument persuasive, the requested relief is granted. The restriction requirement of Aug. 2, 2006 is hereby withdrawn as to Groups IV, V and VI. Claims 27-59 will be rejoined with the elected invention as claimed in claims 60-75. The examiner has been directed to issue an Office action to treat claims 27-59 on the merits after the RCE filed Jun. 14, 2007 is processed.

Conclusion

Based on the analysis of the record, the restriction requirement promulgated in the Office communication dated Aug. 2, 2006 is withdrawn as to Groups IV, V and VI inventions. Non-elected claims 27-59 and the previously elected claims 60-75 have been examined in the Office action mailed Nov. 28, 2007. The relief requested in the petition is granted.

Any inquiry regarding this decision should be directed to Henry C. Yuen, Special Programs Examiner, at (571) 272-4856.

Petition granted.



Karen M. Young, Director
Technology Center 3700